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EXAMINER

FISCHER, ANDREW J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/558,920

Applicant(s)

David Regan

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 10, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-36 and 46-75 is/are pending in the application.
- 4a) Of the above, claim(s) 46-75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Acknowledgments

1. The response and amendment filed October 1, 2002 (Paper No. 7) is again acknowledged. In that response, Applicant canceled claims 1-18 and added new claims 19-45. A restriction by the Examiner regarding claims 19-45 followed (Paper No. 8).

Restriction

2. Applicant's election of Group I (claims 19-36) in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
3. Applicant's amendment filed with Paper No. 9 canceled the non-elected claims, i.e. claims 37-45.

Election of Species

4. Newly submitted claims 45-75 are directed to an invention that is independent or distinct from the invention originally claimed. The application now contains claims directed to the following patentably distinct species of the claimed invention:

Species A: Represented by Figure 15; and

Species B: Represented by Figure 6.

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5. Applicant is normally required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

6. The Examiner finds that additional evidence supports his position that claims 46-75 are drawn to an additional embodiment. See Applicant's response received June 10, 2003 (Paper No. 9), page 1 where Applicant expressly states "New claims 46-75 cover an additional embodiment of the invention."

7. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election in response to this Office Action or in any future amendment, Applicant must indicate which claims are readable upon the elected species. MPEP § 809.02(a).

8. Should Applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. Since Applicant has received an action on the merits (Paper No. 4) for the originally presented Species A, this species has been constructively elected by original presentation for

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prosecution on the merits. Accordingly, claims 46-75 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP §821.03.

10. The Examiner finds that as currently claimed, claim groups 19-27 and 28-36 are not patentably distinct. However if for any reason, Applicant amends the claim groups so that they are patentably distinct, a restriction at that time between the two groups will follow.

Information Disclosure Statement

11. The information disclosure statement filed August 30, 2002 (Paper No. 5) has particular references not considered by the Examiner. These references are duplicates since they were previously listed on the Examiner's Notice of References Cited (Form PTO-892) in Paper No. 4.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 28-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims do not produce a useful, concrete, tangible result. See *In re Warmerdam*, 33 F3d 1354, 31 USPQ2d 1754 (Fed Cir 1994). In this case, the claims do not produce anything but merely recite code segments that may, in the future, do something.

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Claim Rejections - 35 USC § 112

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

15. Claims 28-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The claims are replete with errors. Some examples follow:

- a. The scope of claims 28-36 is unclear. Code segments by themselves do not perform any tasks. See the §101 rejection above.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 19-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over TurboTax Deluxe ("TurboTax"). TurboTax discloses receiving a tax form of a user by a third party government entity (the Internal Revenue Service ("IRS")) utilizing a network (the network is both: electronic i.e, telephone lines, public Internet lines such as backbones, and various computer lines internal and external to the IRS which make up the IRS computer network; and real, i.e, the

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series of IRS offices across the US); storing a record of the tax form in a database of the government entity (inherent); receiving a request utilizing the network (the user requests a copy of a previous year's tax forms;

The Examiner previously took Official Notice that digital certificates stored on a hard drive are old and well known in the art. (See the Previous Office Action on the merits).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify TurboTax to include a digital certificate stored on the user's hard drive. Such a modification would have provide more secure and certain identification of the user. See e.g. Danieli (U.S. 6,510,513).

18. Claims 28-36, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over TurboTax. Since claims 28-36 are not patentably distinct from claims 19-27, the patentability of claims 28-36 rests on the patentability of claims 19-27.

19. Functional recitation(s) using the word "for" (e.g. "for tax form submittal verification" as recited in claim 19) have been given less patentable weight¹ because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the

¹ See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.).

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language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

20. The Examiner concludes that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,² the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only has Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim with which to draw in those statements.³ Third, after receiving express notice in the previous Office Action⁴ of the Examiner's position that lexicography is *not* invoked, Applicant has not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicant has not argued lexicography *is* invoked). Finally and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's

² See the Examiner's previous Office Action on the merits mailed May 21, 2002, Paper No. 4, Paragraph No. 7.

³ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, at the very least, point to a term or terms in the claim with which to draw in those statements." *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁴ See again the Examiner's previous Office Action on the merits, Paper No. 4, Paragraph No. 7.

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express invitation⁵ to be his own lexicographer.⁶ Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process and unless expressly noted otherwise by the Examiner, the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their “broadest reasonable interpretation” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).⁷ The Examiner now relies heavily and extensively on this interpretation.⁸ See e.g. *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1381, 62 USPQ2d 1865, 1877 (Fed. Cir. 2002) (“Because the patentee has not chosen to be his own lexicographer in this instance, [the claimed element] should carry its ordinary meaning”)(Clevenger, J. dissenting

⁵ Id.

⁶ The Examiner’s requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner’s requirements were simply an express request for clarification of how Applicant intend his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO’s goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO’s The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed July 2, 2003).

⁷ See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) (“In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification.”); MPEP §§ 2111 and 2111.01; and *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

⁸ See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]”

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in part). Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

21.

Response to Arguments

22. Applicant's arguments filed October 1, 2002 (Paper No. 7) have been fully considered but they are not persuasive.

Regarding the Prior Art Reference TurboTax

23. Applicant asserts generally that the references do not show all the claimed features.

Applicant's few arguments regarding a particular feature is that "there is no indication or suggestion in this [tax filing] process that a tax form is stored in a database of the IRS

TurboTax doe not disclose that a record of the tax form is stored in a database of the third party government entity" Stated a different way, Applicant seems to argue that the IRS does not store citizen tax forms in a database. While the Examiner concedes that TurboTax and the other cited references may not directly disclose this feature, the Examiner finds that one of ordinary skill in the art would clearly recognize that storing tax forms in a database of the IRS is inherent in the process.

24. This statement shows Applicant's *extremely* low level of skill in this art. Apparently

Applicant believes that once a tax form is filed, the IRS no longer retains the tax form either

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physically or electronically in a database. Again, the Examiner disagrees. For example, if Applicant's statement was true, the IRS would not have this years tax records for any person, last years tax records for any person, or even any previous years' tax records for any person. Tax cheats and criminals would be free from taxes since the IRS would not have *any* records of tax filings. Again, the Examiner disagrees. How does Applicant believe tax records are kept and checked?

25. While the Examiner has considered all arguments by Applicant and all the evidence of record, the Examiner finds that Applicant's statement (that "there is no indication or suggestion in this [tax filing] process that a tax form is stored in a database of the IRS") is *extremely strong* evidence that Applicant is *not* one of ordinary skill in this art.

Modems and Digital Certificates

26. Applicant also argues that "modems are used for dial-up network access and are not used to authenticate someone's identity."⁹ The Examiner disagrees. First, in order to dial-in to a network, the user must have an account. This usually entails a username and password. See for example www.AOL.com or www.Earthlink.net.

27. Applicant also argues "that there is no teaching in TurboTax to suggest the use of a digital certificate with Intuit's tax service." After careful review of the rejection in this Office Action and

⁹ See Applicant's "Remarks" in Paper No. 7, page 8, 2nd paragraph.

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the previous Office Action on the merits, the Examiner is unable to locate where the Examiner relied on *TurboTax* to suggest the use of a digital certificate. This argument is therefore moot.

28. Applicant also argues on the top of page 9 that "Applicant submits that it would not have been obvious under 35 U.S.C. § 103 to combine Applicant's invention with a digital certificate." Because the Examiner has not combined Applicant's invention with a digital certificate, this argument is also moot.

Official Notice

29. Applicant attempts to traverse the Official Notice findings as stated in the previous Office Action (Paper No. 4, Paragraph No. 9) is inadequate. Adequate traversal is a two step process. First, Applicant(s) must state their traversal on the record. Second and in accordance with 37 C.F.R. § 1.111(b) which requires Applicant(s) to specifically point out the supposed errors in the Office Action, Applicant must state *why* the Official Notice statement(s) are not to be considered common knowledge or well known in the art.

30. In this application, the Examiner finds that Applicant has clearly met step (1) since "Applicant requests that the Examiner provide an affidavit or cite a reference in support of the position concerning digital certificates" ¹⁰ Applicant has however failed step (2) since he has failed to argue *why* the Official Notice statement(s) are not to be considered common knowledge

¹⁰ See Applicant's "Remarks" in Paper No. 7, page 9, 2nd paragraph.

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or well known in the art. Because Applicant(s)' traversal is inadequate, the Official Notice statement(s) are taken to be admitted as prior art. See MPEP §2144.03.

31. Applicant argues that he “believes that in the realm of network-based information processing, the use of digital certificates is of such a technical nature that references are required to support in support of rejections.”¹¹ However, being of a “technical nature” is not basis for traversing an officially noticed statement. The Examiner notes that all patent applications are of a “technical nature” since they must be withing the technological arts. *In re Toma*, 575 F.2d 872, 877-78, 197 USPQ 852, 857 (CCPA 1978). Moreover, “[i]n approaching claim construction, we must always be conscious that our objective is to interpret the claims from the perspective of one of ordinary skill in the art, . . . , not from the viewpoint of counsel or expert witnesses” *Dayco Products, Inc. v. Total Containment, Inc.*, 258 F.3d 1317, 59 USPQ2d 1489, 1494-95 (Fed. Cir. 2001) (citations omitted).

32. The standard is therefore not whether the officially noticed fact is of a “technical nature,” but whether one of ordinary skill in the art would find the officially noticed fact to be common knowledge or well known in the art.

33. As noted above, the Examiner finds that digital certificates stored on a hard drive are old and well known in the art. Evidence to support this position can be found the USPTO's Patent classification system in class 713. In particular, subclasses 150 titled “Multiple Computer Communication Using Cryptography” through subclass 181 with special emphasis on subclass

¹¹ Id.

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156 titled "By Certificate." Virtually all patents and publications in class 713, subclass 156 support the Examiner's position.¹²

34. Under the broadest reasonable interpretation standard noted above, the Examiner maintains his interpretations. However, to the extent that the Examiner's interpretations are either different from or in dispute with Applicant(s)' interpretations, the Examiner hereby adopts the following definitions as the broadest reasonable interpretation in all his interpretations:

a. **Server:** "2. On the Internet or other network, a computer or program that responds to commands from a client." Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.¹³ **Client:** "3. On a local area network or Internet, a computer that accesses shared network resources provided by another computer (called a *server*)."
Id. **Computer:** "Any machine that does three things: accepts structured input, processes it according to prescribed rules, and produces the results as output." *Id.*

¹² The classification Notes for subclass 156 state, "**By Certificate:** This subclass is indented under 155. Subject matter wherein the single source provides digital information attesting to a network computers legitimacy." The classification Notes for subclass 155 state, "**Central trusted authority provides computer authentication:** This subclass is indented under 150. Subject matter wherein a single source confirms the legitimacy of a computer on the network or provides logon authorization."

¹³ It is the Examiner's position that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See e.g. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used *Microsoft Press Computer Dictionary* (3d ed.) as "a technical dictionary" used to define the term "flag."

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b. **Database** “: a usu. large collection of data organized esp. for rapid search and retrieval (as by a computer)” Merriam-Webster’s Collegiate Dictionary, 10th Edition, Merriam-Webster Inc., Springfield, M.A., 1997. Additionally, it is the Examiner’s position that the once used *card catalog* is also a database. “**card catalog** n (1854): a catalog (as of books) in which the entries are arranged systematically on cards” *Id.*

c. **Relational Database** “A database or database management system that stores information in tables—rows and columns of data—and conducts searches by using data in specified columns of one table to find additional data in another table. In a relational database, the rows of a table represent records (collections of information about separate items) and the columns represent fields (particular attributes of a record). In conducting searches, a relational database matches information from a field in one table with information in a corresponding field of another table to produce a third table that combines requested data from both tables. . . . Microcomputer database products typically are relational database. *Compare* flat-file database, inverted-list database.” Computer Dictionary *supra*.

d. **Relational Model** “A data model in which the data is organized in relations (tables). This is the model implemented in most modern database management systems.” *Id.*

e. **Table** “1. In programing, a data structure usually consisting of a list of entries, each entry being identified by a unique key and containing a set of related values. A table is often implemented in an array of records, a linked list, or (in more primitive languages) several arrays of different data types all using a common indexing scheme. 2. In relational databases, a data

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structure characterized by rows and columns, with data occupying or potentially occupying each cell formed by a row-column intersection. The table is the underlying structure of a relation.” *Id.*

35. It is the Examiner’s factual determination that all limitations in the examined claims have been considered and are either disclosed or inherent in the references as discussed above.

Furthermore, the inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) (“Preponderance of the evidence is the standard that must be met by the PTO in making rejections.” (citations and quotations omitted)). The preceding discussion in this paragraph regarding the standard for claim rejections applies to all examined claims currently pending.

Conclusion

36. Applicant’s amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

37. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure includes the following: Baker (U.S. 6,567,789 B1); Baker (U.S. 6,473,741 B1); and Sudia (U.S. 5,659,616).

38. Unless expressly noted otherwise by the Examiner, the following two citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8th Edition, Rev 1, February 2003. All remaining MPEP citations within this Office Action are from the MPEP 8th Edition, August 2001.

39. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph antecedent basis and indefiniteness, and §102 and §103 prior art).

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Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as described above.

40. In accordance with *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner cites How Computers Work Millennium Ed. by Ron White; How Networks Work, Millennium Ed. by Frank J. Derfler et. al.; and How the Internet Works, Millennium Ed. by Preston Gralla as additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Since the references are directed towards beginners, the references are primarily directed towards those of *low* skill in the art. Therefore, one of *ordinary* skill in the art must—at the very least—be aware of the knowledge contained within the references.

41. All factual findings and conclusions of law in this Office Action are based the entire record. Although the Examiner may have singled out various items of evidence (e.g. prior art) and expressly noted their content, this does *not* mean that the other documents of record were not contemplated when making the prior art rejections above. Moreover, because the canons of claim construction are generally viewed from a person of ordinary skill in the art,¹⁴ the other documents of record not specifically mentioned in the prior art rejections above were—at the very

¹⁴ See e.g. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986)(noting that the definiteness inquiry focuses on whether those skilled in the art would understand the scope of the claim).

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least—used in the Examiner's deliberative process to access, inter alia, the definiteness of the claims, the level of skill in the art, and ultimately the patentability of the claimed invention.

42. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicant with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his "Remarks" (Paper No. 7 beginning on page 6) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied¹⁵, the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) *in his next properly filed response*. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has *any* questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292.

AJF

July 2, 2003


ANDREW J. FISCHER
PATENT EXAMINER


ROBERT P. OLSZEWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

¹⁵ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.